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| In re Application of                         | : |          |
| Vertommen et al.                             | : |          |
| Application No.: 10/527,246                  | : | DECISION |
| PCT No.: PCT/US03/28519                      | : |          |
| Int. Filing Date: 11 September 2003          | : | ON       |
| Priority Date: 16 September 2002             | : |          |
| Attorney Docket No.: AHP98246                | : | PETITION |
| For: Vaccines Containing Viruses Involved In | : |          |
| Avian Malabsorption Syndrome And             | : |          |
| Methods Of Administration Thereof            | : |          |

This is in response to the petition under 37 CFR 1.47(a) filed on 09 February 2006.

### **BACKGROUND**

This international application was filed on 11 September 2003, claimed an earlier priority date of 16 September 2002, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 16 March 2005. Applicants filed *inter alia* the basic national fee on 09 March 2005.

On 09 August 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), the \$200.00 petition fee is being charged to counsel's Deposit Account No. 01-1425, per the general fee authorization filed on 09 February 2006.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signatures of joint inventors Mathieu Hubert Vertommen and Jacob Jacobus Louwerens be excused because "two separate attempts were made to secure the signatures of Messrs. Vertommen and Louwerens on the Declaration/Power of Attorney for this application," but "to date, no executed papers have been returned by the said inventors..." Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner states that, on 09 November 2005, parcels each containing a copy of a cover letter, a copy of the application as filed, a Declaration/Power of Attorney, and an Assignment were delivered to each of the non-signing inventors. This assertion is corroborated by copies of DHL tracking receipts showing delivery of both parcels on 09 November 2005 (one tracking receipt shows "Signed for by: Lourens," while the other shows "Signed for by: VERTOMM"). The accompanying copies of the cover letters indicate the last-known address for each of the respective non-signing inventors, and petitioner has included copies of the application and declaration and assignment documents sent to them. Petitioner has further provided copies of follow-up letters sent to the non-signing inventors at their last-known addresses, again requesting execution and return of the declaration, as well as copies of DHL tracking reports showing delivery on 16 January 2006. Based on the totality of the evidence presently of record, it would be appropriate to conclude that copies of the application and the declaration document were presented to each of Mr. Vertommen and Mr. Louwerens, and that the failure of each of these

non-signing inventors to execute and return the declaration constitutes a "refusal" within the meaning of 37 CFR 1.47(a).

Regarding requirement (3), the petition includes a statement the last known addresses of Mr. Vertommen and Mr. Louwerens. Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), the petition is accompanied by a declaration document, filed on 09 March 2005, signed by joint inventor Frans Gerrit Davelaar. However, inspection of the declaration reveals that it nominates "Jacob Jacobuw LOUWERENS," while the published international application nominates "LOUWERENS, Jacob, Jacobus." No explanation of this discrepancy appears to be present in the application file. As such, it would not be appropriate to accept said declaration at this time. Accordingly, requirement (4) has not been satisfied.

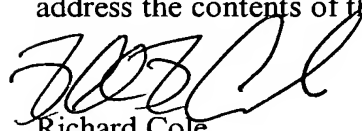
### DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

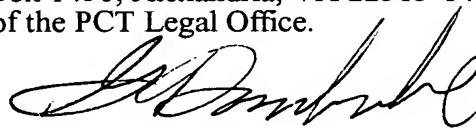
If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

The \$200.00 petition fee is being charged to counsel's Deposit Account No. 01-1425, as authorized by the correspondence filed on 09 February 2006.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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